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Atty Dkt No. GP-302475 (GM0328PUS)

## REMARKS

The following remarks are intended to be fully responsive to the Office Action mailed October 29, 2004.

Claims 1-21 are pending. Claims 17-20 are withdrawn from consideration. The drawings are objected to under 37 CFR § 1.83(a). Claims 4-7 are rejected under 35 USC § 112. Claims 1 and 8-11 are rejected under 35 USC § 102(b) as being anticipated by Pedersen (5,997,058). Claims 12-16 are rejected under 35 USC § 102(b) as being anticipated by McKeon et al (6,349,521). Claims 1 and 4-5 are rejected under 35 USC § 102(b) as being anticipated by Tohda et al (6,447,049). Claims 1-3 are rejected under 35 USC § 102(b) as being anticipated by Gotanda et al (6,712,411). Claims 1 and 4-7 are rejected under 35 USC § 102(b) as being anticipated by Eipper et al (6,224,120). Claim 21 is rejected under 35 USC § 103(a) as being unpatentable over Eipper et al in view of Sundgren et al (6,726,258). Applicants have amended claims 1, 4, 11, 12, 13, and 15 and cancelled claims 2-3 and 14.

### Objections to the Drawings

The Examiner objects to the drawings under 37 CFR § 1.83(a) because claim 11 recites "wherein the bumper includes an integral tab defining a hole for the attachment of vehicle hardware." The Examiner states that "the vehicle hardware of claim 11 must be shown or the feature(s) canceled from the claim(s)." Applicants have amended claim 11 to delete the reference to "vehicle hardware." Accordingly, Applicants submit that the objection to the drawings is overcome.

### Claim Rejections – 35 USC §112

The Examiner rejected claims 4-7 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner rejected claims 4-7 because "[c]laim 4 recites the following limitations: 'an impact load' in lines 3-4 and 'a vehicle impact' in line 4. There is insufficient antecedent basis for these

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limitations in the claim."

Applicants refer the Examiner to MPEP § 2173.05(e), which addresses antecedent basis in claims:

A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to "said lever" or "the lever," where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference. Similarly, if two different levers are recited earlier in the claim, the recitation of "said lever" in the same or subsequent claim would be unclear where it is uncertain which of the two levers was intended. A claim which refers to "said aluminum lever," but recites only "a lever" earlier in the claim, is indefinite because it is uncertain as to the lever to which reference is made.

Applicants submit that the rejection of claim 4 under 35 USC § 112 is improper because the meaning of "an impact load" and "a vehicle impact" is clear to one skilled in the art. Both elements are introduced for the first time in claim 4 and both elements are introduced with "an," rather than "the" or "said," and thus there can be no confusion with a previously recited claim element.

Those skilled in the art will not confuse "an impact load" with "the event of a vehicle impact." An impact load is a load that results from a vehicle impact event.

Nevertheless, Applicants have amended claim 4 to recite "such that a load received by the bumper is at least partially distributed to the two lower rails and the two upper rails."

#### Claim Rejections – 35 USC §102(b)

Claim 1 is rejected under 35 USC § 102(b) as being anticipated by Pedersen (5,997,058), Tohda et al (6,447,049), Gotanda et al (6,712,411), and Eipper et al (6,224,120). Applicants have amended claim 1 to recite a vehicle comprising "a body panel forming a first portion of the vehicle exterior surface; and a metal bumper

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...forming a second portion of the vehicle exterior surface; ... and wherein the first portion and the second portion of the vehicle exterior surface are substantially contiguous."

It should be noted that the limitations added to claim 1 are substantially identical to the limitations of cancelled claim 2, which the Examiner rejected under 35 USC § 102(b) as being anticipated by Gotanda et al. The rejection of claim 2 under 35 USC § 102(b) as being anticipated by Gotanda et al is erroneous. Gotanda et al. issued March 30, 2004, whereas Applicants filing date is August 25, 2003. Accordingly, Gotanda et al is not prior art under §102(b).

Moreover, in rejecting claim 2, the Examiner states that Gotanda et al. discloses that "a body panel 20 forms a first portion of the vehicle exterior surface; wherein the bumper 30 forms a second portion of the vehicle exterior surface ... and wherein the first portion and the second portion are substantially contiguous." However, it is apparent that reinforcement member 30 of Pedersen does not form any part of the "exterior surface" of a vehicle because cover member 20 covers reinforcement member 30 as shown in Figure 2 of Gotunda et al. Gotanda et al state that "[t]he bumper device 10 includes a primary impact energy absorbing body 20 which is constituted of a front skin member 21 and a pad member 22 and forms a cover member, a reinforcement member 30 which is assembled to the primary impact energy absorbing body 20 such that the reinforcement member 30 is fitted into a back surface of the primary impact energy absorbing body 20. . ." Gotunda et al., column 3, lines 36-42. (emphasis added). Thus, being covered by a "cover member" or body 20, reinforcement member 30 does not form part of the "vehicle exterior surface" as recited by amended claim 1 and formerly recited by claim 2.

Furthermore, assuming, *arguendo*, that cover member 20 includes a surface that partially forms the exterior surface of a vehicle, no part of reinforcement member 30 is "contiguous" with that exterior surface, as recited by amended claim 1 and formerly recited by claim 2.

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Accordingly, Applicants submit that amended claim 1 is allowable. Claims 4-11 ultimately depend from claim 1 and are therefore allowable for at least the same reasons that claim 1 is allowable.

Moreover, claim 8 recites "wherein the bumper includes an inner panel and an outer panel operatively connected to the inner panel such that the inner panel and the outer panel define a cavity therebetween." Claim 8 is rejected under 35 USC §102(b) as being anticipated by Pedersen. The Examiner states that Pedersen discloses "a metal bumper 1 mounted with respect to the at least one structural frame member for receiving a load in the event of an impact. . . . [T]he bumper includes an inner panel (Figures 4-6) an an outer panel operatively connected to the inner panel such that the inner panel and the outer panel define a cavity therebetween."

The bumper of Pedersen illustrated in Figures 4-6 "is made from a complete and hollow extruded blank which is manufactured from an extrudable material. . . ." Pedersen, column 4, lines 3-5. The bumper of Pedersen may have "an outer wall portion 2a . . . [and] and an arched inner wall portion 2b," (Pedersen, column 4, lines 9-11, emphasis added) but the "outer wall portion" and the "inner wall portion" are *portions* of a one-piece "hollow extruded blank" and thus are not an "inner panel" and an "outer panel" as understood by those skilled in the art.

Claim 9 recites "wherein the inner panel is characterized by strengthening formations." The Examiner states that "the inner panel [of Pedersen] is characterized by strengthening formations such as 4c (Figure 6)." With regard to element 4c, Pedersen merely states that "[i]ntermediate arched or wavy yoke portions 4c connect the outer wall portion 4a and the inner wall portion 4b." There is no teaching in Pedersen that 4c is a "strengthening formation," as recited by claim 9. The Examiner is reminded that it is well settled that for a § 102 rejection to be proper, **each and every element** set forth in a claim must be **expressly or inherently** described in a single prior art reference. See MPEP § 2131. Pedersen does not *expressly* teach that element 4c is a "strengthening

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formation." Further, element 4c of Pedersen is not *inherently* a "strengthening formation."

Claim 12 is rejected under 35 USC §102(b) as being anticipated by McKeon et al. Claim 12 has been amended to recite "a first one-piece member defining a first generally horizontally-oriented channel, a second generally horizontally-oriented channel spaced a first distance apart from the first generally horizontally-oriented channel, a first generally vertically oriented channel interconnecting the first and second generally horizontally oriented channels, and a second generally vertically oriented channel spaced a second distance apart from the first generally vertically oriented channel and interconnecting the first and second generally horizontally oriented channels."

The elements recited in amended claim 12 are shown in Figure 2 of the present application and are described in paragraph 0022 of the present application. McKeon et al does not disclose "a first one-piece member defining a first generally horizontally-oriented channel, a second generally horizontally-oriented channel spaced a first distance apart from the first generally horizontally-oriented channel, a first generally vertically oriented channel interconnecting the first and second generally horizontally oriented channels, and a second generally vertically oriented channel spaced a second distance apart from the first generally vertically oriented channel and interconnecting the first and second generally horizontally oriented channels."

Accordingly, amended claim 12 is allowable. Claims 13, and 15-16 ultimately depend from claim 12 and are therefore allowable for at least the same reasons that claim 12 is allowable.

Claim 21 is rejected under 35 USC § 103(a) as being unpatentable over Eipper et al in view of Sundgren et al. Claim 21 recites a "bumper having an outer panel and an inner panel operatively connected to the outer panel and at least partially corrugated." The Examiner states that Eipper et al discloses "metal bumper 12 mounted with respect to the two upper rails and the two lower rails ... the bumper inherently

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having an outer panel and an inner panel operatively connected to the outer panel (as is known from U-shaped profiles); wherein the inner panel and the outer panel are characterized by a curvature."

The Examiner is reminded that to rely on the inherency of a claimed element or feature in a prior art reference, the Examiner must provide extrinsic evidence that the claimed element or feature is necessarily present in the reference. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). See also MPEP § 2112.

The Examiner has not shown that an inner panel and an outer panel are necessarily present in Eipper et al. The Examiner merely states that outer panels and inner panels are "known from U-shaped profiles. . ." Eipper et al states that "the front protection bow 12 comprises a U-bow-shaped upper rod profile 18 which is connected with the lower rod profile. . ." As can be seen in Figure 1 of Eipper et al, upper rod 18 is shaped like an inverted "U." There is no disclosure of an inner panel and an outer panel in Eipper et al, nor is there any indication that an inverted U-shaped rod must have an inner panel and an outer panel, as required for a finding of inherency. Indeed, in the cross-sectional view of Eipper's Figure 4, "U-bow-shaped upper rod profile 18" is clearly a solid member that does not include an inner panel and an outer panel. Accordingly, an inner panel and an outer panel is not inherent in a U-shaped profile and is not disclosed in Eipper. Accordingly, the rejection of claim 21 is improper.

## CONCLUSION

This Amendment is believed to be fully responsive to the Office Action mailed October 29, 2004. The remarks in support of the amended claims and the rejected

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claims are believed to place this application in condition for allowance, which action is respectfully requested.

Respectfully submitted

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